

REMARKS

By this amendment, claims 1, 12, 13, 16, and 27 have been amended. **The claims remaining in consideration are claims 1-40.** Claims 1, 2, 16, and 27 are the independent claims remaining under consideration. No new matter has been added by this response.

I. Restriction Requirement

Applicant notes with appreciation the Examiner's acceptance of the arguments presented in traverse of the restriction requirement of January 9, 2006.

II. Claims Indicated As Allowable

Applicant appreciates the Examiner's indication of claims 6-8, 15, 18, 19, and 26 as allowable and claims 27-40 as allowable if amended to overcome the rejection under 35 U.S.C. §112.

III. Objections To Drawings

The Examiner has noted inconsistencies in the figures of the present application. In response thereto, the presents corrected drawing sheets herewith to address these matters. Applicant requests reconsideration of these objections.

IV. Objections To Specification

The Examiner has generally noted the presence of informalities in the specification of the present application. In particular, the Examiner refers to the reference numerals used in figures 11-21 of the specification and the description of Fig. 20 as illustrated a set of bias springs, which are actually shown in Fig. 21. To the extent Applicant understands the Examiner's objections, the specification has been amended to address these specifically cited matters. Furthermore, Applicant has reviewed the specification and attempted to address all other identified informalities. To the extent the Examiner has additional specific concerns regarding

informalities in the specification that have not been addressed by Applicant's amendments herein, Applicant will make every further effort to appropriately address such concerns. Applicant requests reconsideration of these objections.

V. Objections To Claims

The Examiner has noted specific informalities not related to patentability in claims 1, 13, and 16. Applicant has amended claims 1, 13, and 16 to address these matters. Applicant requests reconsideration of these objections.

VI. Rejections Under 35 U.S.C. §112

The Examiner has rejected claims 2 and 27 under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully requests reconsideration of this rejection.

The Examiner has based this rejection on the premise that it is unclear which embodiment of the invention Applicant is claiming in claims 2 and 27, specifically, due to the incorporation of a "position fixture" element in claim 2 and a "maintenance device" in claim 27.¹ To the extent Applicant understands the Examiner's rejection, it appears that the Examiner is seeking to limit the scope of each of claims 2 and 27 to one of the two preferred embodiments disclosed in the specification of the pending application. *See* Office Action, ¶9 ("It is therefore unclear to which embodiment of the invention the applicant is claiming rendering the claims indefinite for the purposes of examination.") (emphasis added).

It is a fundamental tenet of U.S. patent law that limitations from preferred embodiments disclosed in the specification are not to be incorporated into the claims. *See e.g. Rodime PLC v. Seagate Technology, Inc.*, 174 F.3d 1294, 1303, 50 USPQ2d 1429, 1435 (Fed. Cir. 1999), *cert.*

¹ Applicant also notes that "position fixture" is also used in the description of the first embodiment. *See* Specification, p. 12.

denied, 528 U.S. 1115 (2000), (“the district court erred by importing the functions of a working device into these specific claims, rather than reading the claims for their meaning independent of any working embodiment.”). Simply put, the claims of an application do not claim disclosed embodiments. However, that appears to be precisely what the Examiner is requesting Applicant to do in responding to this rejection. Therefore, Applicant respectfully asserts that this is not a proper ground for rejection of claims under 35 U.S.C. 112.

VII. Rejection Under 35 U.S.C. §102

The Examiner has rejected claims 1-5, 9-17, and 20-25 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 3,968,560 to Vial (“the ‘560 patent”). The applicant requests reconsideration of this rejection.

The unequivocal view of the Federal Circuit is that a single reference must teach, *i.e.*, identically describe each and every element of the rejected claim for a proper rejection under 35 U.S.C. § 102. *See Atlas Powder v. E.I. duPont*, 750 F.2d 1569, 224 U.S.P.Q. 409 (Fed. Cir. 1984). Applicant notes that many of the Examiner’s stated rejections appear to be based on either misinterpretation of the scope of the elements contained in Applicant’s claims or misinterpretation of the structures described in the ‘560 patent. Furthermore, Applicant notes that the Examiner has not identified the structures described in the ‘560 patent that are contended to be corresponding to elements of Applicant’s claims in several of the stated rejections. Without this information, it is difficult for Applicant to fully evaluate and respond to each of the Examiner’s stated rejections. However, Applicant has made every effort to reasonably interpret the most likely basis for each rejection and respond as fully as possible thereto.

Independent claim 1 includes the following limitations:

- providing an automated pallet dispensing station having ... a block dispensing station;
and
- providing a plurality of blocks to the block dispensing station.

The '560 patent lacks each of these elements as it contains only a stringer feeder and loader and no apparatus for loading and dispensing blocks.

Independent claim 2, upon which claims 3-5 and 9-15 depend, similarly refers to the dispensing of blocks rather than stringers and requires "at least one block dispenser, said block dispenser being disposed to dispense a block to an assembly station." Again, the '560 patent fails to disclose or suggest any apparatus for the dispensing of blocks. Further, claim 2 requires a position fixture disposed to operatively cooperate with said second slat driver and said at least one block dispenser. The Examiner has not identified a position fixture disclosed within the '560 patent in conjunction with the rejection of claim 2. However, Applicant notes that in paragraph 22 in relation to the rejection of claim 14, the Examiner refers to item 179 (Figs. 11 and 12). Applicant notes that the elements of the '560 patent identified by the Examiner are not position fixtures as they do not position blocks or any other item. Rather, they merely "engage the stringers of the pallet as the stringers leave the nailing anvil" to simply advance them. '560 Patent, column 10, lines 31-33. Therefore, the '560 does not disclose the requisite position fixtures of claim 2.

The '560 patent also fails to disclose a clamping device disposed to clamp each dispensed block against an individual slat as required by claim 4. Once again, the Examiner has failed to identify the specific structure disclosed in the '560 patent that is believed to correspond to the clamping device. However, for the sake of this response, Applicant assumes that the allegedly corresponding structure of the '560 patent is item 150 (Figs. 7-10). Applicant notes that neither this stop bar nor any other structure of the '560 patent clamps the deck boards and stringer against one another as required by claim 4. Instead, the assembly of the '560 patent moves the deck boards and a first stringer into an abutting relationship against the laterally positioned stop bar with no clamping action.

Claim 11 requires that the first and second slat drivers include chains and that said chains turn in operative coordination through a gear set. Again, the Examiner has not identified the structures of the '560 patent corresponding to the claims elements of claim 11. However, for the

sake of responding to the rejection, Applicant assumes that the Examiner is referring to the chains (20) of the stringer feeder and the index pallet conveyor (178) of the '560 patent as corresponding to the first and second slat drivers of claim 11. Applicant first notes that the Examiner has apparently misinterpreted the language of claim 11. Contrary to the Examiner's stated rejection, claim 11 does not refer to the chains of the first and second slat driver "each [turning] in a gear set." Instead, claim 11 states that "said chains turn in operative coordination through a gear set." Second, Applicant is unable to find any reference or suggestion in the disclosure of the '560 patent that refers to the stringer feeder chains (20) and the index pallet conveyor as turning in operative coordination through a gear set. Rather, each of the stringer feeder chains and the index pallet conveyor appear to be controlled by separate limit switches that are activated by the pallet.

Claim 12 requires that the block dispenser comprise a piston with a tooth. As is inherent in the original claim language, the tooth engages a block to dispense it. The Examiner has identified item (116) as the structure disclosed in the '560 patent as corresponding to the tooth of claim 12. Applicant notes that this reference numeral refers generally to the stringer lifting assembly. This assembly utilizes a "stringer pocket assembly" (121) to rotate each stringer. No tooth is described.

Applicant respectfully suggests that the Examiner has misinterpreted the scope of claim 13. The claim refers the second slat driver as comprising at least one drive wheel. To assist in the Examiner's interpretation of this claim, Applicant has amended claim 13 herein to expressly reference that the drive wheel engages the slat to advance it. Applicant believes that this clarification was clearly inherent in the original claim language when properly read in light of the specification. The Examiner has not identified the structure of the '560 patent that is alleged to correspond to the claimed drive wheel, but upon review of the '560 patent, Applicant respectfully asserts that the '560 patent does not disclose or suggest a drive wheel anywhere within its disclosure.

As previously noted in the above discussion concerning the Examiner's rejection of claim 2, Applicant notes that the elements of the '560 patent identified by the Examiner, specifically lugs (179), are not position fixtures as they do not position blocks, or any other item for that matter. Rather, they merely "engage the stringers of the pallet as the stringers leave the nailing anvil" to simply advance them. '560 Patent, column 10, lines 31-33. Therefore, the '560 does not disclose the requisite position fixtures of claim 14.

Applicant's claim 16 requires the steps of dispensing first and second blocks to abut individual slats at preconfigured locations on the slat. The examiner refers to item 14 identified in the '560 patent as being a block dispensed by the machine. However, item 14 actually refers to an elongated stringer which is attached to multiple deck boards (12). The machine of the '560 patent does not dispense or position blocks on slats.

As the Examiner indicates, the '560 patent describes the ejection of a finished pallet. In contrast, Applicant's claim 20 requires the ejection a finished stringer, not a finished pallet. These are clearly and obviously two different items. The machine of the '560 does not eject finished stringers because it does not assemble stringers; it is neither capable of nor intended to do so.

With respect to the Examiner's rejection of claim 21, Applicant once again notes that the elements of the '560 patent identified by the Examiner, specifically lugs (179), are not position fixtures as they do not position blocks, or any other item for that matter. Rather, they merely "engage the stringers of the pallet as the stringers leave the nailing anvil" to simply advance them. '560 Patent, column 10, lines 31-33. Therefore, the '560 does not disclose the requisite position fixtures of claim 21.

Similarly, Applicant respectfully asserts that the Examiner's rejection of claim 22 is flawed because lugs (179) associated with index conveyor (178) do not position blocks but instead merely advance the stringers of the pallet. Applicant does note for clarification that the step of claim 22 requires only the execution of said driving step in part by at least one other driver. The claim is not limited to a driver having position fixtures attached thereto.

Similarly to claim 11, claim 23 requires that the first and second slat drivers include chains and connecting said chains through a gear set. The Examiner has not identified the structures of the '560 patent corresponding to the claims elements of claim but, as in the above discussion concerning claim 11, Applicant assumes that the Examiner is referring to the chains (20) of the stringer feeder and the index pallet conveyor (178) of the '560 patent as corresponding to the first and second slat drivers referenced in claim 23. Applicant is unable to find any reference or suggestion in the disclosure of the '560 patent that refers to the stringer feeder chains (20) and the index pallet conveyor as turning in operative coordination through a gear set. Rather, each of the stringer feeder chains and the index pallet conveyor appear to be controlled by separate limit switches that are activated by the pallet.

Claim 24 refers to the slats as being dispensed from a magazine that is adjustable to dispense different size slats. The Examiner has only identified reference numeral 34 in the '560 patent in stating the rejection of claim 24. Applicant notes that item 34 in the '560 refers generally to the stringer feeder rather than to a slat or deck board feeder, magazine, or particular adjustable structure associated therewith. The stringer feeder of the '560 patent is described in detail in columns 5 and 6, while the deck board feeder is described in column 6. No adjustment mechanism is described in connection with either of these structures of the '560 patent.

With respect to claim 25, Applicant again submits that the '560 patent does not disclose or suggest a block dispenser or block magazine because it is not designed or intended to manufacture block stringers.

Therefore, it is clear that the '560 patent does not disclose each element of claims 1-5, 9-17, and 20-25 and cannot support a proper rejection of those claims under 35 U.S.C. §102. The applicant respectfully requests reconsideration of these rejections.

VIII. Non-Statutory Double Patenting Rejection

The Examiner has rejected claims 1, 2, 13, 16, and 17 based on non-statutory double patenting over claims 1-11 of U.S. Patent No. 6,763,567 ("the '567 patent"). Applicant respectfully requests reconsideration of a portion of this rejection.

Claim 2 of the current application introduces the element of position fixtures disposed to operatively cooperate with slat drivers and block dispensers to position a dispensed block on a slat. Applicant notes that no claims of the '567 patent make reference to a position fixture. Claim 6, to which the Examiner makes reference in the discussion of claim 2, does not refer to any position fixtures. Instead, claim 6 only references the automatic biasing of blocks into engagement with a guide surface of the assembly apparatus. Claim 6, as a method rather than apparatus claim, appropriately does not specify the structure by which such automatic biasing must be accomplished.

Applicant does wish to note that claim 7 of the '567 patent is not limited to the use of a separate driver for the steps of using the assembly apparatus to automatically move slats between the referenced positions.

Applicant submits herewith a terminal disclaimer with respect to claims 1, 13, 16, and 17 of the present application.

IX. Conclusion

It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Response is respectfully requested.

Respectfully submitted,



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